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MAILED

MAR 25 2009

OFFICE OF PETITIONS

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| In re Application of | : | |
| NOMURA et al. | : | |
| Application No. 10/765,048 | : | LETTER REGARDING |
| Filed: January 28, 2004 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 04853.0111 | : | |

This is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR REVIEW OF CALCULATION" filed September 24, 2008. Pursuant to applicants' duty of good faith and candor to the Office, applicants request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **532 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 1, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 567 days. On September 24, 2008, applicants submitted the instant comment. Applicants disclose that they believe that the determination of patent term adjustment of 567 days is incorrect and should be set at 561 days.

Applicants assert that they are entitled to an additional patent term adjustment of 11 days pursuant to 37 CFR 1.703(a)(2).¹ Applicants stated that the Office mailed a nonfinal Office action on January 29, 2007, which was subsequently withdrawn in favor of the corrected nonfinal Office action of March 27, 2007. Applicants contend that the Office should have used the March 27, 2007 mailing date of the corrected nonfinal Office action for the purpose of calculating any adjustment of patent term pursuant to 37 CFR 1.703(a)(2). Applicants assert they filed a Response to Restriction Requirement on November 16, 2006. However, the Office did not respond to the reply until the mailing of the corrected nonfinal Office action on March 27, 2007, four months and 11 days later. Thus, applicants contend that an additional period of adjustment of 11 days should be entered.

Applicants' argument has been considered. However, in light of the application history, it has been determined that the additional period of adjustment of 11 days for Office delay pursuant to 37 CFR 1.702(a)(2) is not merited. It is undisputed that the Office mailed a nonfinal Office action on January 29, 2007, within four months of the reply of November 16, 2006. On March 27, 2007, the Office mailed a corrected nonfinal Office action, which withdrew the nonfinal Office action of January 29, 2007, and restarted the period for reply.

The subsequent mailing of another Office action under 35 U.S.C. 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A)(ii),² applicants

¹ 37 CFR 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

² 35 U.S.C. 154(b)(1)(A) provides that:

– Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to–

are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first four months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until January 29, 2007. The fact that the Office later withdrew the nonfinal Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2)³ on January 29, 2007. Thus, it is correct for the Office to use the date of January 29, 2007, in calculating any period of adjustment due to the examination delay in responding to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, a period of adjustment of 11 days pursuant to 37 CFR 1.702(a)(2) is not warranted and will not be entered.

Applicants further disclose that the filing of a Supplemental Information Disclosure Statement (Supplemental IDS) could be a basis for a period of reduction of 17 days. A review of the application history reveals that applicants submitted the Supplemental IDS on June 20, 2008, after filing a reply to the final Office action on May 16, 2008. The record does not support a conclusion that the examiner expressly requested the filing of the Supplemental IDS. Further, a review of the Supplemental IDS, filed June 20, 2008, reveals that applicants

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken[.]

³ 37 CFR 1.702 provides:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

did not include a statement under 37 CFR 1.704(d).⁴ Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application. The period of adjustment of the term of the patent should be reduced pursuant to 37 CFR 1.704(c)(8)⁵ by 35 days (not 17 days), counting the number of days beginning on the day after the date the initial reply in the form of an amendment was filed, May 17, 2008, and ending on the date that the Supplemental IDS was filed, June 20, 2008.

In view thereof, the correct patent term adjustment at the time of mailing of the notice of allowance is **532 days**.

As this letter was submitted to advise the Office of an error in applicants' favor, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the

⁴ 37 CFR 1.704(d) provides:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

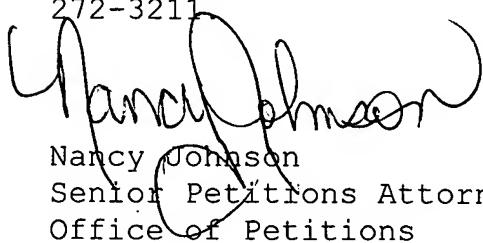
⁵ 37 CFR 1.704(c) provides that the following circumstance constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen

PTA Calculations for Application: 10/765048

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|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 01/28/2004 | PTO Delay (PTO): | 567 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 532 |
| PTO Delay Adjustment: | -35 | | |

File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|--------|------------|--|-----|------|-------|
| 75 | 03/23/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 35 | |
| 60 | 07/01/2008 | MAIL NOTICE OF ALLOWANCE | | | 0 |
| 59 | 06/27/2008 | ISSUE REVISION COMPLETED | | | |
| 58 | 06/27/2008 | DOCUMENT VERIFICATION | | | |
| 57 | 06/27/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 56 | 06/27/2008 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 55 | 06/27/2008 | NOTICE OF ALLOWABILITY | | | |
| 51 | 06/20/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 50 | 06/20/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 49 | 06/03/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 48 | 06/03/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 47 | 05/28/2008 | DATE FORWARDED TO EXAMINER | | | |
| 46 | 05/16/2008 | AMENDMENT AFTER FINAL REJECTION | | | |
| 45 | 03/17/2008 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 44 | 03/11/2008 | FINAL REJECTION | | | |
| 43 | 01/02/2008 | DATE FORWARDED TO EXAMINER | | | |
| 42 | 12/17/2007 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 41 | 09/17/2007 | MAIL NON-FINAL REJECTION | | | |
| 40 | 09/13/2007 | NON-FINAL REJECTION | | | |
| 38 | 06/27/2007 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 37 | 07/10/2007 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 06/27/2007 | RESPONSE AFTER NON-FINAL ACTION | | | |

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|------|------------|---|-----|--|----|
| 35 | 03/27/2007 | MAIL NON-FINAL REJECTION | | | |
| 34 | 03/19/2007 | NON-FINAL REJECTION | | | |
| 33 | 03/19/2007 | MAIL NOTICE OF WITHDRAWN ACTION | | | |
| 32 | 03/19/2007 | LETTER WITHDRAWING / VACATING OFFICE ACTION | | | |
| 31 | 01/29/2007 | MAIL NON-FINAL REJECTION | | | |
| 30 | 01/22/2007 | NON-FINAL REJECTION | | | |
| 29 | 08/19/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 28 | 07/20/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 27 | 12/05/2006 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 11/16/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 25 | 10/16/2006 | MAIL RESTRICTION REQUIREMENT | 567 | | -1 |
| 24 | 01/20/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 23 | 04/08/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 22 | 09/09/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 21 | 09/08/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 20 | 07/20/2004 | REFERENCE CAPTURE ON IDS | | | |
| 19.7 | 08/19/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 08/19/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 18 | 07/20/2004 | OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL) | | | |
| 17.7 | 07/20/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 17 | 07/20/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 01/28/2004 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 15 | 01/28/2004 | PRELIMINARY AMENDMENT | | | |
| 14 | 01/28/2004 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 12 | 08/07/2004 | APPLICATION RETURN FROM OIPE | | | |
| 11 | 08/07/2004 | APPLICATION RETURN TO OIPE | | | |
| 10 | 08/07/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 9 | 08/09/2004 | APPLICATION IS NOW COMPLETE | | | |
| 8 | 07/20/2004 | ADDITIONAL APPLICATION FILING FEES | | | |
| | | A STATEMENT BY ONE OR MORE INVENTORS | | | |

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|---|------------|---|--|--|
| 7 | 07/20/2004 | SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | |
| 6 | 06/14/2004 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | |
| 5 | 03/23/2004 | CLEARED BY L&R (LARS) | | |
| 4 | 03/11/2004 | REFERRED TO LEVEL 2 (LARS) BY OIPE CSR | | |
| 3 | 03/11/2004 | CASE CLASSIFIED BY OIPE | | |
| 2 | 03/04/2004 | IFW SCAN & PACR AUTO SECURITY REVIEW | | |
| 1 | 01/28/2004 | INITIAL EXAM TEAM NN | | |

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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